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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,223	12/27/2000	Robert H. Daniels	5100-0005	6599
20855	7590	03/10/2004	EXAMINER	
ROBINS & PASTERNAK 1731 EMBARCADERO ROAD SUITE 230 PALO ALTO, CA 94303			COUNTS, GARY W	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/750,223

Applicant(s)

DANIELS ET AL.

Examiner

Gary W. Counts

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_


Claim(s) objected to: \_

Claim(s) rejected: \_

Claim(s) withdrawn from consideration: \_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_.
10. ☐ Other: \_\_\_\_

  
LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

  
Gary W. Counts  
Examiner  
Art Unit: 1641

03/08/04

## **DETAILED ACTION**

### **Attachment to Advisory Action**

This paper is presented in order to address the Applicant's remarks set forth in the response to advisory action dated December 15, 2003.

Continuation of 5 NOTE: Applicant argues that Applicants are unaware of any provision in the Patent Statutes requiring submission of a 103(c) Declaration at a particular time.

With respect to the statement "there is no evidence in the application why evidence of a 103(c) was not presented earlier,". If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier and failure to do so may result in non-entry (CFR 1.116).

Applicant argues that since the Examiner stated the Declaration had been considered, he cannot be basing this statement on the fact that it was filed after a final rejection. Thus, clarification regarding the statement is respectfully requested.

This is not found persuasive because Examiner considered the Declaration for entry into the application only. Further, the Declaration did not on its face place the application in condition for allowance.

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Applicant argues that upon further review by applicants' in-house counsel, it became apparent that Bruchez was indeed an inventor of subject matter claimed in the present application. This is not found persuasive because while the Declaration filed April 28, 2003 in paper No. 11 states Bruchez is not an inventor, the Declaration filed October 10, 2003 states that Bruchez is an inventor without any explanation of this inconsistency.

Applicant argues that the rejection has not been set forth with particularity such that applicants can address the rejection herein or in an appeal brief. Applicant states that this is wholly improper and that it is also improper to make such an art rejection in an Advisory Action. This is not found persuasive because it is not improper to say that something is well known. Further, Examiner has not incorporated this statement in the form of an art rejection. The office is indicating that the Declaration filed April 28, 2003 contradicts the Declaration filed October 10, 2003 and thus creates new issues that require further consideration. Applicant is advised that an amendment to the claims not only affects the limitations recited in the claim but also affects the inventorship.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W. Counts whose telephone number is (571) 2720817. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary W. Counts  
Examiner  
Art Unit 1641  
February 26, 2004